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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,708	03/30/2004	Jang-Hou Ha	SKYIP2.001AUS	7379

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EXAMINER	
AHMED, AFFAF	

ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
03/27/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/813,708	HA ET AL.	
	Examiner	Art Unit	
	AFAF AHMED	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 03/30/2004.

2. Claims 1-28 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Applicant is advised to review all claims for clarity under 35 USC § 112. The following are some examples of unclear and indefinite claims:

- Claims 1 and 5 recite the limitation of: *issuing one or more coupons for playing a lottery game to an advertiser, wherein the one or more coupons, are designed to be electronically distributed.*
- Claims 2 and 16recite the limitation of: *purchasing one or more lottery game tickets from a lottery gaming authority.*

It is unclear what is the relationship between purchasing lottery ticket to play a game and issuing coupon for playing the game. Appropriate correction and or clarification is required.

- Claims 1 and 5 recite the limitations of:
  - *issuing one or more coupons for playing a lottery game to an advertiser, wherein the one or more coupons, are designed to be electronically distributed.*
  - *receiving a request for playing the lottery game from a lottery player having such a coupon*

It is unclear how issuing one or more coupons for playing a lottery game to an advertiser, results in receiving a request for playing the lottery game from a lottery player having such a coupon. Appropriate correction and or clarification is required.

5. Claim 21 recites the limitation of: *wherein the player selects his own numbers for playing the lottery game as he desires.* The term "desires" in claim 21 is a relative term which renders the claim

indefinite. The term "desire" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Appropriate correction and /or clarification is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5, 19 are rejected under 35 U.S.C. 112, second paragraph.

- Claim 5 recites the limitation of: *wherein the one or more coupons are configured to be distributes to the public*. There is insufficient antecedent basis.
- Claim 19 recites the limitation of: *wherein the at least one lottery game ticket is purchased prior to the permission to play the game*. There is insufficient antecedent basis.

8. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures .may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuda et al, US Pat No: 6,251,016 in view of Aronin US Pat No: 6,454,650.

Claims 1, 2, 5, 8, 12, 16, 17, 24, 25 and 26:

Tsuda discloses:

- *receiving a request for playing the lottery game from a lottery player having such a coupon* (see at least column 6, lines 62-65, column 7, lines 1-14 and fig 3 with associated text);
- *determining whether the player's coupon is valid for playing the lottery game* (see at least column 8, lines 30-36 and fig 13 with associated text);
- *upon validation of the coupon, enabling to transmit data of an advertisement of the advertiser to a computer device of the player* (see at least column 5(lines 3-19, 52-56) and column 8, lines 30-36) *thereafter, permitting the player to play the lottery game* (see at least column 6, lines 62-67);

Tsuda does not disclose:

- *issuing one or more coupons for playing a lottery game to an advertiser, wherein the one or more coupons, are designed to be electronically distributed;*

However, Aronin in at least in at least column 2, lines 46-67 discloses lottery participants are automatically linked to information about products or services advertised by various Internet vendors. Lottery participants are not required to make a purchase. And in at least column 3, lines 1-8 Aronin discloses that lottery participants are allowed to play the lottery over the Internet as the cost to play the lottery is shifted from participants to the advertisers or internet vendors to the advertiser. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine that coupons are used to link lottery participants to the lottery authority and used to appropriately charge the correct advertiser for the lottery participants being able to play the lottery at no charge, which is equivalent in functionality to applicant's invention.

- *wherein the server comprises a lottery coordinator configured to electronically purchase one or more lottery game tickets from a lottery gaming authority*;

However, Aronin in at least column 7, lines 65-67 and in at least column 8, lines 1-9 discloses that in order for lottery participant to submit his or her selection of numbers to the lottery authority web server, participant must choose to receive information about one of several products advertised on the game web page by clicking the hyperlinks, where lottery participant is connected through URL to vendor's web page while the submission to the lottery authority is processed and verified. Therefore, it would have been obvious to

one of ordinary skill in the art to conclude that Aronin discloses an implied purchase of a lottery ticket by the advertiser thereby allowing the lottery participant who has responded to the advertiser to play the lottery without paying, which is equivalent in functionality to applicant's invention.

- *displaying an advertisement for a predetermined period of time* (see at least column 7, lines 65-67 and column 8, lines 1-9).

It would have been obvious to one of ordinary skill in the art to include in the offering free lottery of Tsuda's over the Internet the ability for advertisers to seamlessly purchase lottery tickets from lottery authority as taught by Aronin since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 3, 10, and 11:

Tsuda / Aronin disclose the limitations as shown above.

Tsuda further discloses:

- *wherein the server comprises a code creator configured to create an identification code for each individual coupon, and wherein the identification code is used for the validation of the coupon* (see at least column 5, lines 3-19 and 52-56).

Claim 4:

Tsuda / Aronin disclose the limitations as shown above.

Tsuda does not disclose, however, Aronin does disclose:

- *wherein the server comprises a lottery game manager configured to connect to a computer network of a lottery gaming authority and configured to coordinate the lottery game play* (see at least column 3, lines 9-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Tsuda's information offering system for providing a lottery on a network with Aronin's free lottery system with the motivation of correctly billing advertiser when a particular ad is selected by lottery participant.

Claim 6:

Tsuda / Aronin disclose the limitations as shown above.

Tsuda further discloses:

- *wherein the coupons are electronic coupons* (see at least column 2, lines 15-26).

Claims 9, 13, 27 and 28:

Tsuda / Aronin disclose the limitations as shown above.

Tsuda further discloses:

- *wherein the coupons are distributed to persons who are visiting the subscriber's web site or clicking a banner advertisement of the subscriber on a web site* (see at least column 5, lines 40-51).

Claim 14:

Tsuda / Aronin disclose the limitations as shown above.

Tsuda further discloses:

- *receiving the advertisement data from the subscriber prior to the receipt of the request* (see at least column 4, lines 41-62).

Claim 19:

Tsuda / Aronin disclose the limitations as shown above.

Tsuda does not disclose:

- *wherein the at least one lottery game ticket is purchased prior to the permission to play the game*.

However, Aronin in at least column 3, lines 1-8 discloses that lottery participants are allowed to play the lottery over the Internet as the cost to play the lottery is shifted from participants to the advertisers or internet vendors. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to conclude that lottery tickets are purchased prior playing the game, which is equivalent in functionality to applicant's invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Tsuda's information offering system for providing a lottery on a network with Aronin's free lottery system with the motivation of correctly billing advertiser when a particular ad is selected by lottery participant.

Claim 20:

Tsuda / Aronin disclose the limitations as shown above.

Tsuda does not disclose, however, Aronin does disclose:

- *wherein the at least one lottery game ticket has pre-selected numbers for the lottery game* (see at least column 7, lines 52-56);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Tsuda's information offering system for providing a lottery on a network with Aronin's free lottery system with the motivation of maximizing consumers' choices of numbers.

Claims 21-23:

Tsuda / Aronin disclose the limitations as shown above.

Tsuda does not disclose, however, Aronin does disclose:

- *wherein the player selects his own numbers for playing the lottery game as he desires.*
- *wherein the at least one lottery game ticket is purchased after the selection of the numbers and includes the player selected numbers.*
- *informing the player as to whether he has won in the lottery game.*

See at least column 3, lines 16-26, column 7, lines 65-67 and column 8, lines 1-9.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Tsuda's information offering system for providing a lottery on a network with Aronin's free lottery system with the motivation of giving consumers more choices and engaging consumers to participate in the lottery game.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Archer, US Pat No 6,277,026 teaches system and method for facilitating the purchase and sale of lottery tickets online.
- Howson, US Pat No: 6,540,608 teaches lottery.
- Noh et al, US Pat No: 2001/0051896, teaches system for electronic mail gift coupon and transmitting method thereof.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private

PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.
AA

/Yehdega Retta/
Primary Examiner, Art Unit 3622